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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,799	04/13/2001	Enno Christophers	3774-4	1948

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EXAMINER

DUFFY, PATRICIA ANN

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/833,799

Applicant(s)

CHRISTOPHERS ET AL.

Examiner

Patricia A. Duffy

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 17 May 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 102 rejections of record.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 37-43.

Claim(s) objected to: _____.

Claim(s) rejected: 26-36.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Pat. A. Duffy
Patricia A. Duffy
Primary Examiner
Art Unit: 1645

Continuation of 5. does NOT place the application in condition for allowance because: The rejection of claims 26-36 under 112, first paragraph as lacking written description stands for reasons made of record. Applicants argue that the amendment to cDNA obviates the written description issue with respect to comprising language. This is not persuasive. Applicants have not disclosed a full-length cDNA encoding a full length protein. The inhibitory protein disclosed is a mere fragment of something larger. The full length of the larger protein has not been disclosed and neither has the cDNA encoding such. The recitation of cDNA does not cure this issue. None of the figures 15-19 address the missing cDNA or piece of the full length polypeptide. *Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116.) *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404, 1405 held that: To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966. An adequate written description of a DNA, such as the cDNA of the recombinant plasmids and microorganisms of the '525 patent, "requires a precise definition, such as by structure, formula, chemical name, or physical properties," not a mere wish or plan for obtaining the claimed chemical invention. *Fiers v. Revel*, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993). Accordingly, "an adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself." *Id.* at 1170, 25 USPQ2d at 1606. The name cDNA is not itself a written description of that DNA; it conveys no distinguishing information concerning its identity. While the example provides a process for obtaining human insulin-encoding cDNA, there is no further information in the patent pertaining to that cDNA's relevant structural or physical characteristics; in other words, it thus does not describe human insulin cDNA. Describing a method of preparing a cDNA or even describing the protein that the cDNA encodes, as the example does, does not necessarily describe the cDNA itself. No sequence information indicating which nucleotides constitute human cDNA appears in the patent, as appears for rat cDNA in Example 5 of the patent. Accordingly, the specification does not provide a written description of the invention of a cDNA comprising because Applicants have not disclosed the full length cDNA or protein sequence. Applicants' arguments are again not persuasive with respect to the "fragments" of the claimed sequence that have inhibitory activity. Applicants again assert that the specification does describe fragments of the claimed sequence that are inhibitory. Applicants are in error. The specification at pages 25-26 provide for "polypeptides therein partially sequenced" (specification page 25, third full paragraph). Therefore the sequences as set forth as Component A-E are admittedly by applicants teachings in the specification to be only partial sequences of a larger polypeptide that is Component A-E. With respect to Components A-D, it is absolutely clear from a direct sequence comparison, that the partial sequence provided for each of these components establishes that they are not a fragment of the claimed sequence. In fact they are sequences that contain additional amino acids not contained in the claimed polypeptide sequence. With respect to Component E, while on its face appears to be a fragment of the sequence set forth in claim, the specification admits that it is a partial sequence of a larger polypeptide. It is the isolated components A-E that were apparently tested for inhibitory activity and not the apparent partial sequences set forth in the paragraph bridging pages 25-26. It is unclear as to what specific portion of pages 25-26 that Applicants are relying upon to assert that any fragment of the claimed sequence has been established by the specification as filed to possess inhibitory activity. The examiner maintains that a fair reading of pages 25-26 of the specification indicate that there are no clearly disclosed fragments of the claimed sequence that possess inhibitory activity.